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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,411	06/26/1999	CAROL CORPUS	CORPP101US	9031

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/344,411

Applicant(s)

CORPUS ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7-15 and 17-39 is/are pending in the application.
- 4a) Of the above claim(s) 19-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7-15,17,18,38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

REJECTIONS REPEATED

1. The 35 U.S.C. §103 rejection of claims 1, 2, 5, 6, 7, 9, 17, 18, 38, and 39 over Griffin et al. (4,696,706) is repeated for reasons previously of record in paper #28, pages 4-5, paragraph #5.

Griffin et al. discloses a stack of adhesive symbols comprising a plurality of process logic symbols (leaves) and a dispenser board (base leaf). Each logic symbol comprises a non-adhesive top surface and bottom surface with a layer of adhesive. The adhesive (removable adhesive) on the logic symbol is strong enough to secure any symbol to an object and yet let the logic symbol be removed without damage to the object. The dispenser board comprises a non-adhesive top surface and a bottom surface with a layer of adhesive. The adhesive (mounting adhesive) on the dispenser board is use for mounting the board on a wall or any smooth surface. A protective layer is added to the dispenser board adhesive to prevent the board from being prematurely or accidentally attached to an object. From the figures it can be seen that the dispenser board has a thickness greater then the logic symbols. See column 4, line 17 through col. 5, line 64 and the figures.

Griffin also discloses that it may be necessary to use rather large, firm logic symbols on a blackboard for educational purpose or for a large exhibit purpose (col. 6, lines 45-47).

Furthermore, the exact size of the logic symbols is deemed to be a cause effective variable with regard to intended surface the symbols is to be placed. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective

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variable such as the size of the logic symbols through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the logic symbol as suggested by Griffin depending on its specific intended use.

Also, the phrase “for conformal application thereon to the surface, ...” in claim 17, is an intended use. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

2. The 35 U.S.C. §103 rejection of claims 8, 10, 11, and 12 over Griffin et al. (4,696,706) in view of Cleef et al. (2,248,317) is repeated for reasons previously of record in paper #18, pages 4-5, paragraph #13.

Griffin et al. discloses all the limitations of the instant claimed invention except for the leaves having an active agent and peeling means.

Cleef discloses a sticker packet comprising a plurality or set of superposed stickers. The stickers are adapted when stripped apart or separated from one another to be stuck to any selected surface of object and, depending upon their shape, serve as articles of utility or ornamentation. The stickers are thin and flexible and are secured together in packet form by means of facings of permanently tacky pressure-sensitive adhesive (col. 2, lines 2-10). The stickers are made of base material of paper or like material. The stickers are provided with a thin coating of shellac, varnish, lacquer, or ethyl cellulose in order to prevent the permanently tacky

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pressure-sensitive adhesive from sticking too tightly (col. 2, lines 19-32). As shown in figure 1, the stickers are provided with integral outwardly projecting tabs (col. 3, lines 4-6).

It would have been obvious to one of ordinary skill the art at the time the invention was made to add a thin coating of shellac, etc as taught by Cleef to the logic symbol of Griffin because the coating would help prevent the stacked symbols from sticking to each other. It also would have been obvious to add a tab as taught by Cleef to the logic symbol of Griffin because it would help facilitate separation between the stacked symbols.

3. The 35 U.S.C. §103 rejection of claims 13-15 over Griffin et al. (4,696,706) in view of Cleef et al. (2,248,317) and further in view of Bowskill et al. (4,795,669) is repeated for reasons previously of record in paper #18, pages 5-6, paragraph #14.

Griffin et al. and Cleef disclose all the limitations of the instant claimed invention except for the tabs comprising adhesive.

Bowskill discloses a disposable protective shield for a handle or illumination device comprising a stack of shields, each shield comprises a relatively-thin flexible sheet made from any suitable material such as a plastic type of "crepe paper". The sheet further has a top surface pr side and an underside and a band of adhesive on the underside of each sheet around the perimeter thereof. (Col. 4, lines 18-32) The shield may also be provided with a flap (tab). The bottom of the flap may be coated entirely with a suitable adhesive. (Col. 4, lines 57-68)

It would have been obvious to one of ordinary skill in the art to add an adhesive to the tab of Cleef as taught by Bowskill because it would prevent the tab from prematurely coming up. Also, it would have been obvious to one having ordinary skill in the art at the time the invention

was made to have adhesive on both sides of the tab, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

ANSWERS TO APPLICANT'S ARGUMENTS

4. Applicant's arguments filed in paper #29 regarding the 35 U.S.C. §103 rejection of Griffin et al. (4,696,706) in view of Cleef et al. (2,248,317) have been carefully considered but are deemed unpersuasive.

Applicant argues that claims 8 and 10-12 depend from claim 1, and claim 1 had previously been amended by clarifying a structural feature or shape limitation of the stack of leaves. Applicant further argues that Griffin does not teach or suggest such an element. Claim 1 was amended, the previous response, to recite "the stack of said leaves being sized to conformably cover an entire exposed surface." This limitation does not give any specifics on the size of the leaves or the size of the exposed surface. Also, "to conformably cover an entire exposed surface" is an intended use. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Furthermore, Griffin discloses that it may be necessary to use rather large, firm logic symbols on a blackboard for educational purpose or for a large exhibit purpose (col. 6, lines 45-47). The exact size of the logic symbols is deemed to be a cause effective variable with regard to intended surface the symbols is to be placed. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the

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size of the logic symbols through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the logic symbol as suggested by Griffin depending on it's specific intended use.

Applicant further argues that Cleef also does not teach "the stack of said leaves being sized to conformably cover an entire exposed surface." Cleef was relied upon only for the teaching of the leaves having an active agent and peeling means and not for the limitation "the stack of said leaves being sized to conformably cover an entire exposed surface." Therefore, Applicant's arguments regarding Cleef not teaching this limitation is moot, since the reference was not relied upon to teach this limitation.

5. Applicant's arguments filed in paper #29 regarding the 35 U.S.C. §103 rejection of Griffin et al. (4,696,706) in view of Cleef et al. (2,248,317) and further in view of Bowskill et al. (4,795,669) have been carefully considered but are deemed unpersuasive.

Applicant argues that claims 13-15 depend from claim 1 and Griffin and Cleef fail to teach or suggest each and every element of the invention as claimed. The arguments regarding the deficiencies of Griffin and Cleef have already been addressed above.

Applicant further argues that Bowskill also does not teach "the stack of said leaves being sized to conformably cover an entire exposed surface." Bowskill was not relied upon for teaching the limitation "the stack of said leaves being sized to conformably cover an entire exposed surface." Therefore, Applicant's arguments regarding Bowskill not teaching this limitation is moot, since the reference was not relied upon to teach this limitation.

6. Applicant's arguments filed in paper #29 regarding the 35 U.S.C. §103 rejection of Griffin et al. (4,696,706) have been carefully considered but are deemed unpersuasive.

Applicant argues claim 1 had previously been amended by clarifying a structural feature or shape limitation of the stack of leaves. Applicant further argues that Griffin does not teach or suggest such an element. Claim 1 was amended, the previous response, to recite "the stack of said leaves being sized to conformably cover an entire exposed surface." This limitation does not give any specifics on the size of the leaves or the size of the exposed surface, nor does it really clarify a structural feature or shape limitation of the stack of leaves. Furthermore, "to conformably cover an entire exposed surface" is an intended use. There are no specifics on what size the leaves or the surface have to be. There is also not specific type of surface that the leaves have to cover.

Griffin discloses that it may be necessary to use rather large, firm logic symbols on a blackboard for educational purpose or for a large exhibit purpose (col. 6, lines 45-47). The exact size of the logic symbols is deemed to be a cause effective variable with regard to intended surface the symbols is to be placed. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the size of the logic symbols through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the logic symbol as suggested by Griffin depending on it's specific intended use.

Applicant further argues that Griffin merely describes the dispenser board as being mounted on a chalkboard, wall, or smooth surface. Thus, it is at least implicitly if not explicitly clear that the dispenser board is not of a size to conformably cover an entire exposed surface. As pointed out, Applicant does not specify the exposed surface to be covered. Furthermore, Griffin does not disclose that the leaves can only be put on chalkboards. Therefore, if chalkboard sized leaves were put on post-it notes they would cover the entire surface of the post-it note.

Applicant further argues that the intended use of the logic symbols is explicitly demonstrated in Griffin et al figure 3. That is, they are of a size that is intended to not conformably cover the whole or entire surface, but rather to provide a computer programmer or a logic designer a simple method of quickly and rapidly developing logic flowcharts or designs. Griffin.

Griffin discloses that the logic symbols are deployed on a flowchart, but does not disclose the size of the flowchart (background information). Griffin discloses that it may be necessary to use rather large, firm logic symbols on a blackboard for educational purpose or for a large exhibit purpose (col. 6, lines 45-47). If someone used a large exhibit logic symbol on small paper, like a post-it note, it would cover the entire surface.

The fact is that the limitation “sized to conformably cover an entire exposed surface” does not specify what the actual sizes of the leaves are or what the size of the exposed surface is. Since Applicant has not disclosed either size of the leaf or the surface the limitation is completely relative to what is defined as an exposed surface and where the leaf can be applied.

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Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

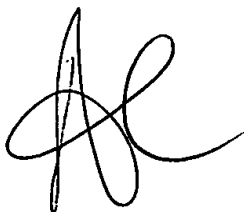
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9306. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

8/13/03



HAROLD PYON
SUPERVISORY PATENT EXAMINER

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